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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,105	11/17/2003	Souji Kihira	117797	9764
25944	7590	04/22/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			MAYO III, WILLIAM H	
			ART UNIT	PAPER NUMBER
			2831	

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/713,105	Applicant(s) KIHIRA, SOUJI
Examiner William H. Mayo III	Art Unit 2831

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

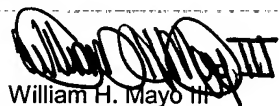
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-6.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached comments.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


William H. Mayo III
Primary Examiner
Art Unit: 2831

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed April 04, 2005 have been fully considered but they are not persuasive. Specifically, the applicant argues the following:
 - A) By reciting a "metallic pipe" in the specification, the term "rigid" is supported under the statute of 35 USC 112, first paragraph.
 - B) By reciting "the two ends of the main shield portion 51 are fixed directly to two shield cases 11 and 21, stresses may be generated at the fixed portions due to vibrations thereof", the term "rigid" is supported under the statute of 35 USC 112, first paragraph and therefore one of ordinary skill in the art would understand that the main shield portion is substantially rigid.
 - C) AOAPA and Morgan, either separate or together, teach or suggest the main shield portion being made of substantially rigid metal pipe and therefore the rejection under 35 USC 103(a) is improper because the foil shields of Morgan are not substantially rigid.
 - D) The Office Action states merely alleges that metallic sheets forming shields are commonly utilized as shields, however the mere fact that certain result characteristics may occur in the prior art doesn't provide mere inherency and therefore the rejection under 35 USC 103(a) is improper.

With respect to argument A, the examiner respectfully traverses. Firstly, it must be stated that the examiner is required to give the claims the broadest reasonable interpretation. Specifically, MPEP 2111 states:

During patent examination, the pending claims must be "given *>their< broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).< Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

Given the broadest interpretation of the term metallic pipe, the Webster's Dictionary defines the term pipe as

"Pipe-a hollow cylinder or tube of material".

Based on the definition of pipe, one of ordinary skill in the art can determine that a metallic pipe, would be a hollow cylinder or tube of metal. In light of the broadest reasonable interpretation stated above, clearly Morgan teaches a metallic sheath that is formed as hollow cylinder or tube of material which is made of a metallic material and therefore clearly discloses a metallic pipe as defined by the broadest reasonable interpretation stated above.

With respect to argument B, the examiner respectfully traverses. 35 USC 112, first paragraph clearly states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains,

or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Clearly, by stating "the two ends of the main shield portion 51 are fixed directly to two shield cases 11 and 21, stresses may be generated at the fixed portions due to vibrations thereof", one of ordinary skill in the art would not state that this provides support for the term "rigid". Specifically, this part of the specification doesn't in a full, clear, concise, and exact way define the main shield portion as being rigid.

Hypothetically, one might state that the main shield portion exhibiting stresses may be rigid, however, this is the precise reason why the statute of 35 USC 112, first paragraph was written, so that the actual metes and bounds of the invention may be determined. Abiding by the guidelines of 35 USC 112, first paragraph, that there is no speculation of characteristics or properties, but rather a full, clear, concise, and exact understanding of what the claimed invention encloses. Based on the statute, the rejection under 35 USC 103(a) of claims 1-6 as failing to comply with the written description requirement, is proper and just because the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to arguments C & D, the examiner respectfully traverses. It should be stated that the 35 USC 103(a) rejection is based on both AOAPA and Morgan.

AOAPA teaches a well known shielded wire harness comprises a plurality of wires (Page 1, lines 11-18); a plurality of wire-side terminals respectively connected to an end

portions of the wires (Page 1, lines 11-18), and configured to be connected respective terminals disposed within a shield case of an equipment (Page 1, lines 11-18), wherein in order to protect prior art wire harness from bounced stones and the like, there is employed a structure in which the wires and shielding member are stored in an armored case made of high-strength material such as metal (Page 2, lines 15-18). The applicant also states that the main shielding member of the present invention exhibits this same characteristic. Specifically, the applicant states on Page 17, lines 11-14:

According to the invention, since the main shield portion is composed of a metal-made pipe, it not only can fulfill a shielding function but also can positively protect the wires from object such as bounced stones.

Clearly, if the claimed invention is hypothetically made of a rigid metallic tube that provides this characteristic, then certainly the AOAPA metallic tube must be made of the same material as that of the claimed invention since it exhibits the same characteristic. MPEP 2112 discloses that

The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983).

In this case, while the applicant has admitted that the shield of the prior art exhibits the same characteristics disclosed by the claimed invention, the applicant's disclosure of the prior art doesn't specifically disclose that the shield is made of a rigid tube.

Art Unit: 2831

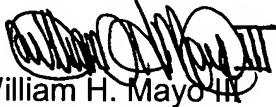
However as disclosed above, the structure of the shield must inherently be made of the same material as the claimed invention because they disclose the same characteristics. Secondly, the applicant discloses that the Morgan teaches a flexible shield because the shields are folded backwards. This statement is an assumption based on no knowledge of the cable art. Clearly, rigid shields of cables are almost always folded backwards to ensure a good connection between the grounding shield and the cable shield as shown and taught in Morgan (Col 3, lines 41-48). Secondly, Morgan clearly teaches that the cable (10) itself, is normally rigid and hard to flexibly bend (Col 1, lines 17-18). So how is it, that the cable is rigid, however the shields are bend backwards? The answer is because the shield layer is cut horizontally in sections in order to fold individual section of the shield backward, which is also taught by Morgan (Col 3, lines 30-40), because a rigid shield layer itself cannot be folded upon itself, without the cuts or slits. Therefore, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the main shield portion of modified AOAPA to comprise a metallic sheet forming the shield, which inherently would be substantially rigid because metallic sheets forming shields are commonly utilized as shield, rather than braided shields which cannot shield the interior components entirely, because of there ability to cover the interior components entirely and therefore prevent external noise such as EMI and RFI from interfering with the interior components.

Conclusion

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (571)-272-1978. The examiner can normally be reached on M-F 8:30am-6:00 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William H. Mayo III
Primary Examiner
Art Unit 2831

WHM III
April 11, 2005

